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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,225	08/28/2003	Ralf Dreibholz	ZAHFRI P528US	6369
20210	7590	11/15/2004	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151			PANG, ROGER L	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/650,225	DREIBHOLZ ET AL.
	Examiner Roger L Pang	Art Unit 3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 October 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13-24 is/are pending in the application.  
 4a) Of the above claim(s) 18 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 13-17 and 19-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 14 October 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3-19-04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

The following action is in response to communications filed for application 10/650,225 on October 4, 2004.

### ***Election/Restrictions***

Applicant's election of Transmission 1 in the reply filed on October 4, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 18 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 4, 2004.

### ***Drawings***

The drawings were received on 10-4-04. These drawings are approved.

### ***Specification***

The disclosure is objected to because of the following informalities: the reference numeral page (page 13) should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant points out in the specifications that one of the positive locking elements may function as a starting element, however, applicant failed to disclose which one and how this would work. It appears that both positive locking elements are locked during 1st gear, but this does not necessarily make them a starting element.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-17, and 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 13, applicant claims a first group of elements that are engaged for an up-shift, and a second group of elements that are disengaged for the up-shift. As stated, all member of the first group would have to be engaged for an up-shift, and all second elements would have to be disengaged for the up-shift. This is not the case. Applicant should amend accordingly (possibly specifying that at least one of the first elements is engaged during the up-shift, etc.).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Zaiser. With regard to claim 13, Zaiser teaches an automatic transmission comprising: a plurality of shift control elements (Fig. 1); a first group of shift control elements K1/K2; and a second group of shift control elements 19/20/21.

Claims 13-16, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Sefcik. With regard to claim 13, Sefcik teaches an automatic transmission comprising: a plurality of shift control elements (Fig. 1); a first group of shift control elements 18/20/36/38; and a second group of shift control elements 26/28/30/32/34. With regard to claim 14, Sefcik teaches the transmission, further comprising at least one of a planetary gearwheel and a spur gear stage (Fig. 1). With regard to claim 15, Sefcik teaches the transmission, wherein the up-shift can be carried out as a powershift. With regard to claim 16, Sefcik teaches the transmission, wherein the positive-locking shift control elements can be closed to transmit torque in both rotation directions. With regard to claim 19, Sefcik teaches the transmission, wherein the positive-locking shift control elements can be actuated mechanically or hydraulically (depending on

actuator). With regard to claim 20, Sefcik teaches the transmission, wherein at least one of the plurality of shift control elements 36 is made as a brake. With regard to claim 21, Sefcik teaches the transmission, further comprising at least one multiple-shaft planetary transmission, at which one of a power split and a power summation takes place, so that a defined transmission ratio can be established (Fig. 1). With regard to claim 22, Sefcik teaches the transmission, wherein the at least one multiple shaft planetary transmission is formed as a dual planetary gearwheel assembly. With regard to claim 23, Sefcik teaches the transmission, wherein the shift control elements 18/20/36/38 which are engaged during a traction up-shift and are disengaged during a traction down-shift, are formed as frictional shift control elements. With regard to claim 24, Sefcik teaches the transmission, wherein at least one of the frictional shift control elements 20 is provided as a starting element.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaiser as applied to claim 13 above, and further in view of Bender. Zaiser teaches the transmission, wherein at least one of the positive-locking shift control elements 20 is a mechanical clutch, but lacks the teaching of said clutch being a claw coupling. Bender teaches a positive-locking clutch 26 in a transmission, made as a claw coupling (Col. 4). It would have been obvious to one of ordinary

skill in the art at the time of the invention to modify Zaiser to employ a claw clutch in view of Bender in order to provide a simplified clutching means.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hiraiwa and Haka have been cited to show similar transmissions with different types of clutches.

Fukui and Oshidari have been cited to show interchangeable positively-locking and frictional clutches.

Hayabuchi, Kasuya, and Taniguchi have been cited to show similar transmissions.

**FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roger L Pang whose telephone number is 703-305-0445. The examiner can normally be reached on 5:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roger L Pang  
Patent Examiner  
Art Unit 3681

November 11, 2004